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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413				
EXAMINER				
MIZRAHI, DIANE D				
ART UNIT		PAPER NUMBER		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/510,089

**Applicant(s)**

EBIHARA ET AL.

**Examiner**

DIANE MIZRAHI

**Art Unit**

2165

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 September 2008.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 20-36 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 20-36 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 04 October 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

Claims 20-36 are currently pending in the subject application and are presently under consideration. Claims 1-19 have been canceled.

This office action is in response to the newly submitted remarks filed September 26, 2008.

***Response to Arguments***

Applicant's arguments filed September 26, 2008 have been fully considered but they are not persuasive.

Applicant argued:

- a) The rejection of claims 20-36 under 35 U.S.C. 101.
- b) The specification is objected to for failing to provide proper antecedent basis for the claimed subject matter such as " process code" in the original specification of Claim 26-29 and 36. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o) and the rejection under 35 USC 112.

Examiner's Response:

With regards to a) Examiner appreciates the interpretation description given by Applicant in response. Applicant discloses "computer readable medium" is Applicant's "portable recording media" and further proclaims "that Applicants are in no way disclaiming their right to have the claims interpreted as broadly consistent with the entire application", however there are no description or language indicative of limiting the interpretation of this limitations. Therefore, taking into consideration but without drawing limitations from the specification into the claim, the limitations "computer readable medium" can be interpreted as broadly consistent with the entire application as "so-called package software" (Applicant's specification, page 50, lines 14-15) or "license information recording medium further stores a parameter corresponding to the property definition data as data constituting the property selection list" (Applicant's specification, page 12, lines 23-25 to page 13, lines 1-2). Applicant has claimed "various storage medium, including software. Therefore, Examiner disagrees with the Applicant's interpretation of "computer readable medium" and maintains the rejection under 35 USC 101.

With regards to b) Examiner appreciates the interpretation description given by Applicant in response. Applicant discloses "process code" however there are no description or language indicative of limiting the interpretation of this limitations. Therefore, taking into consideration but without drawing limitations from the specification into the claim, the limitation, "process code" can be interpreted as broadly consistent with the entire application as code data (Claim 5); or (i.e. performing a

determination process of determining whether any of the text data, the code data, and the numerical data matching the property definition data as the data constituting the property selection list is contained in the property list stored in the storage unit) (Applicant's specification, page 15, lines 6-14) or (i.e. process setting code that sets, for each of the property definition data, a process mode depending on whether data corresponding to the property definition data is present in a property list) (Applicant's specification, page 12, lines 18-21) or "program codes" (Applicant's specification, page 18, line 14). Therefore, Examiner disagrees with the Applicant's interpretation of "process code" and maintains the objection under the objection to the specification and the rejection under 35 USC 112, *infra*.

Examiner disagrees with the Applicant and maintains the office action as state below:

### **Specification**

The specification is objected to for failing to provide proper antecedent basis for the claimed subject matter of Claim 26-29 and 36. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o).

Claims 20-26 and 36 recites "*computer readable medium*". There is no mention of a "*computer readable medium*" in the original specification.

Regarding Claims 26-36, the claims recite a "*process code*". There is no mention of a "*process code*" in the original specification.

Appropriate correction is required.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 26-29 and 36 are rejected under 35 U.S.C. 101 because the claimed invention is directed non-statutory subject matter.

Claims 26-29 and 36 lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. They are, at best, functional descriptive material *per se*.

There does not appear to be a specific and deliberate definition of the term "***computer readable medium***" in the disclosure as originally filed.

There does not appear to be intrinsic evidence of what applicant intends term computer readable medium and program to include in the disclosure as originally filed.

Accordingly, examiner is obliged to approach extrinsic evidence to determine what one of ordinary skill in the art at the time of the invention would reasonably consider term computer readable medium to include data structures, program modules or other data, carrier waves or other transport mechanisms.

In prior art reference Lee et al. (US Publication Number 20030126139, filed 12-28-2001), term computer readable medium appears to include embodiments "media typically embodies computer readable instructions, data structures, program modules or other data in a *modulated data signal such as a carrier wave or other transport mechanism* and includes any information delivery media" (see Lee et al., disclosure, page 19, lines 8-16).

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 20-36 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The "process code" is critical or essential to the practice of the invention, but not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). The amended claims 20-36 include the limitation, "process code", but Examiner is unclear as to what is Applicant's "process

code". There is no mention as to what is this "process code" in the original filed specification.

Examiner notes that according to 37 CFR 1.53 No new matter may be introduced into an application after its filing date. The newly added limitation, "a process code defining a comparison for the information processing apparatus to perform between the attribute information list and the property selection list" is considered new matter, because the claimed, "process code" is not described in the originally filed disclosure and thus considered as new matter. Examiner request Applicant to point out where in Applicant's specification "process code" is taught.

Correction is required.

#### ***Allowable Subject Matter***

Claims 20-36 would be allowable if *rewritten or amended* to overcome the rejection(s) under 35 U.S.C. 112, First paragraph, and the rejection under 35 USC 101 set forth in this Office action.

The following is an examiner's statement of reasons for allowance:

The prior art of records does not teach the combination of claimed elements including: "before acquiring a content key for decrypting the content, determining whether the type and function included in the attribute information list matches the data contained in the property selection list, in which the property selection list, in particular, includes a process code defining a comparison for the information processing apparatus



to perform between the attribute information list and the property selection list when comparison includes when the type and function matches, granting access, and when the type and function do not match, the information processing apparatus denies the access to the content". Thus, prior art of record neither render obvious nor anticipates the combination of claimed elements in light of the specification.

Applicant is invited to further amendment the claims to overcome the prior art made of record. At this time, the claims are not allowable over the prior art made of record.

### ***Response to Arguments***

Applicant's arguments with respect to the claims have been considered but are moot in view the detailed rejection above, based in Applicant's arguments and remarks, and the rejection stated in this office action.

### ***Other Prior Art Made of Record***

The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. U.S. patents and U.S. patent application publications will not be supplied with Office actions. Examiners advises the Applicant that the cited U.S. patents and patent application publications are available for download via the Office's PAIR. As an alternate source, all U.S. patents and patent application publications are

available on the USPTO web site ([www.uspto.gov](http://www.uspto.gov)), from the Office of Public Records and from commercial sources. For the use of the Office's PAIR system, Applicants may refer to the Electronic Business Center (EBC) at <http://www.uspto.gov/ebc/index.html> .

**THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Diane D. Mizrahi whose telephone number is 571-272-4079. The examiner can normally be reached on Monday-Thursday (9:30 - 4:30 p.m.).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christian Chase can be reached on (571) 272-4190. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 305-3900 for After Final communication.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

/Diane Mizrahi/

*Diane.Mizrahi@USPTO.gov*

Primary Patent Examiner  
Technology Center 2100

December 29, 2008

